



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,815	10/03/2000	Espen Skjaeran	28170-00023	5535

7590 12/16/2003

Stanley R Moore Esq  
Jenkins & Gilchrist P C  
1445 Ross Avenue  
Suite 3200  
Dallas, TX 75202-2799

EXAMINER

YUSSUF, SAJID

ART UNIT	PAPER NUMBER
----------	--------------

2141

DATE MAILED: 12/16/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/677,815

Applicant(s)

SKJAERAN ET AL.

Examiner

Sajid A Yussuf

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/03/2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 1 rejected under 35 U.S.C. 102(e) as being anticipated by Mortsof et al. (US Patent No. 6,229,804 and Mortsof hereinafter).

1. As per claim 1 Mortsof discloses an Arrangement in a H.323 network (See Column 3 Lines 32-55) comprising a number of gatekeepers which each are connected to a number of users characterized in that the gatekeepers are arranged hierarchically (See Abstract and Column 1 Lines 5-17) in the sense that each gatekeeper knows a higher level gatekeeper (except the "top" node) (i.e., hierarchy) and a number of lower level gatekeepers (except the "bottom" nodes) (i.e., hierarchy) (See Column 4 Lines 53-67 and Column 5 Lines 1-29).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-3 rejected under 35 U.S.C. 103(a) as being unpatentable over as being unpatentable over Mortsof et al. (US Patent No. 6,229,804 and Mortsof hereinafter) in view of Gardell et al. (US Patent No. 6,128,304 and Gardell hereinafter).

2. As per claims 2 and 3, Mortsof discloses the claimed invention as described above.

However, Mortsof does not explicitly teach characterized in that the calling user issues a Set-up command which is received by a connected first gatekeepers, said first-gatekeeper performs a user location algorithm on its locally attached users, if this algorithm fails, said first gatekeeper send a Location Request message to its lower level gatekeepers, each lower level gatekeeper perform an user location algorithm on its attached users and lower level gatekeepers, if these user location algorithms fail, said first gatekeeper send a Location Request message to its higher level gatekeeper, which performs an user location algorithm on its attached users and gatekeepers except the originating gatekeeper, if one of the user location algorithms succeed, the gatekeeper concerned sends a Location Confirm message to the first gatekeeper, the first gatekeeper sends a Set-up message to the gatekeeper which has issued the Location

Confirm message, which gatekeeper forwards said Set-up message to the called user, whereupon said connection is established.

Gardell teaches characterized in that the calling user issues a Set-up command (i.e., Admissions Request (ARQ)) which is received by a connected first gatekeeper, (See Gardell Column 8 Lines 46-67) said first-gatekeeper performs a user location algorithm on its locally attached users, (See Gardell Column 8 Lines 55-60) if this algorithm fails, said first gatekeeper send a Location Request message to its lower level (i.e., second gatekeepers) gatekeepers, (See Gardell Column 9 Lines 17-64) each lower level gatekeeper perform an user location algorithm on its attached users and lower level (i.e., third gatekeeper) gatekeepers, if these user location algorithms fail, said first gatekeeper send a Location Request message to its higher level gatekeeper, which performs an user location algorithm on its attached users and gatekeepers except the originating gatekeeper, (See Gardell Column 9 Lines 17-65) if one of the user location algorithms succeed, the gatekeeper concerned sends a Location Confirm message (i.e., LCF) to the first gatekeeper, (See Gardell Column 8 Lines 55-67) the first gatekeeper sends a Set-up message (i.e., ACF) to the gatekeeper which has issued the Location Confirm message, (See Gardell Column 8 Lines 55-67) which gatekeeper forwards said Set-up message to the called user, whereupon said connection (i.e., complete the call) is established (See Gardell Column 9 Lines 1-15).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Mortsof with the teachings of Gardell to characterize in that the calling user issues a Set-up command which is received by a connected first gatekeepers, said first-gatekeeper performs a user location algorithm on its locally attached users, if this algorithm fails, said first gatekeeper send a Location Request message to its lower level gatekeepers, each lower level gatekeeper perform an user location algorithm on its attached users and lower level gatekeepers, if these user location algorithms fail, said first gatekeeper send a Location Request message to its higher level gatekeeper, which performs an user location algorithm on its attached users and gatekeepers except the originating gatekeeper, if one of the user location algorithms succeed, the gatekeeper concerned sends a Location Confirm message to the first gatekeeper, the first gatekeeper sends a Set-up message to the gatekeeper which has issued the Location Confirm message, which gatekeeper forwards said Set-up message to the called user, whereupon said connection is established with the motivation to provide for a

communications system that provides for a communication between a packet based network and a conventional circuit network... whether or not the party's terminal is on-line, (See Gardell Column 2 Lines 53-60).

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

A. Patel et al. (US Patent No. 6,314,284) discloses system and method for providing service transparency for mobile terminating calls within an H.323 system;

B. Galasso et al. (US Patent No. 6,374,302) discloses method and system to provide an action control post master gatekeeper;

C. Li et al. (US Patent No. 6,591,301) discloses methods and systems for controlling network gatekeeper message processing; and

D. Bennefeld et al. (US Patent No. 6,519,249) discloses scalable gatekeepers in an Internet telephony system and a method of operation;


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sajid A Yussuf whose telephone number is (703) 305-8752. The examiner can normally be reached on Monday-Thursday 7:30-5:00 PM and Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

---

Sajid Yussuf  
Patent Examiner  
Technology center 2100  
11 December 2003

  
RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER